

09/885,259

- 4 -

PC18174A

REMARKS**STATUS OF THE CLAIMS**

Claims 34, 36, and 48-52 were pending in the application. Claims 34, and 50-52 have been amended in the instant response. New claim 53 has been added. Claims 34, 36, and 48-53 will be pending if the present amendment is entered.

Applicants request that the present amendments be entered as the amendments place the claims in condition for allowance or in better form for consideration on appeal.

I. FIRST REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner has rejected claims 34, 36, and 48-52 under 35 U.S.C. § 103(a), as allegedly being obvious in view of by US Patent No. 5,837,460 ("the '460 patent"). The Office Action alleged that the '460 patent discloses a method for ameliorating the effects of inflammation, including rheumatoid arthritis in a mammal comprising administering a therapeutically effective amount of a M-CSF antigen or antibody to a M-CSF antibody, and characterized these methods as "active immunization." The Office Action alleged it would have been obvious to substitute the claimed "passive immunization" method of treating rheumatoid arthritis with an antibody to M-CSF for the passive immunization methods of the '460 patent.

In addition, Applicants respectfully maintain that claims 34, 36, and 48-52, as amended, are not obvious in view of the '460 patent under 35 U.S.C. § 103(a). As set forth in M.P.E.P. § 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. In addition, the cited references, alone or in combination, must supply all of the elements of the claimed invention.

The presently amended claims all require that the M-CSF antibody inhibit the synergistic effect of M-CSF on MCP-1 mediated shape change. There is no disclosure in the '460 patent of an M-CSF antibody that can inhibit the synergistic effect of M-CSF on MCP-1 mediated shape change. Accordingly, the '460 patent does not disclose all of the elements of the claimed invention. The '460 patent does not disclose all of the elements of the claimed invention and a *prima facie* case of obviousness has not been shown.

09/885,259

- 5 -

PC18174A

Therefore, the claimed invention is not obvious in view of the cited references. Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

II. SECOND REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 34, 36, and 48-52 under 35 U.S.C. § 103(a) as allegedly being obvious over Lopez et al. (WO 00/09561) in view of Campbell et al (1998, IDS) "as is evidence [sic] from Campbell et al. (2000, IDS)." The Office Action states that although Campbell et al (1998, IDS) did not explicitly mention M-CSF, that it referenced the general knowledge of one skill in the art by providing a citation to Metcalf et al. (1991) and Hamilton et al. (1980). The Office Action further alleges that Campbell et al. (2000, IDS) reference the general knowledge in the art by stating that Metcalf et al. (1991) and Hamilton et al. (1980) disclose that Colony-Stimulating Factors are a family of growth factors that include M-CSF and GM-CSF. The Office Action alleged that it would have been obvious to apply the disclosure of Campbell et al. (1998) to that of Lopez et al., which allegedly discloses the use of GM-CSF antibodies to treat rheumatoid arthritis to obtain the presently claimed invention.

Applicants assert that the claims are not obvious in view of Lopez et al. in view of Campbell et al. (1998) as further evidenced by Campbell et al. (2000), or additionally in view of Metcalf et al. (1991) and Hamilton et al. (1980). As set forth in M.P.E.P. § 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. In addition, the cited references, alone or in combination, must supply all of the elements of the claimed invention.

The presently amended claims all require that the M-CSF antibody inhibit the synergistic effect of M-CSF on MCP-1 mediated shape change. There is no disclosure in Lopez et al., Campbell et al. (1998), Campbell et al. (2000), Metcalf et al. (1991), or Hamilton et al. (1980), alone or in combination, of an M-CSF antibody that can inhibit the synergistic effect of M-CSF on MCP-1 mediated monocyte shape change. Accordingly, Lopez et al., Campbell et al. (1998), Campbell et al. (2000), Metcalf et al. (1991), or Hamilton et al. (1980), do not disclose all of the elements of the claimed

09/885,259

- 6 -

PC18174A

invention and a *prima facie* case of obviousness has not been shown. Therefore, the claimed invention is not obvious in view of the cited references. Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

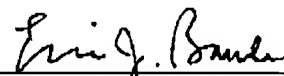
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance is respectfully requested.

If the Examiner believes that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at 734-622-2095.

Respectfully submitted,

Dated: June 29, 2005



Eric J. Baude

Registration No. 47,413
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105
Telephone: (734) 622-2095
Facsimile: (734) 622-1553